



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,939	11/13/2003	Samuel Zellner	030392 (BLL-0126)	4821
36192 7590 12/12/2007 CANTOR COLBURN LLP - BELLSOUTH 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER SHEDRICK, CHARLES TERRELL	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,939

Applicant(s)

ZELLNER, SAMUEL

Examiner

Charles Shedrick

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 10 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 2, 4-6, 8, 9, 11-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/07 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2,4-6,8-9, 11-19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mun et al. US Patent Pub. No. 2003/0022659 A1, hereinafter, "Mun" in view of Hwang US Patent. Pub. No.: 2003/0092432

Consider **claims 1,8 and 15**, Mun teaches a Method, A storage medium including machine readable computer program code, and a System for transmitting enhanced originator information over a communication network (i.e., see at least abstract regarding Caller ID information) comprising: retrieving a service profile for a recipient terminal from a service profile database (i.e., HLR, VLR, or storage system within the MSC) in response to initiation of a communication by an originator terminal to the recipient terminal (i.e., see at least paragraphs 0031-0033, figure 5 and claim 10); the service profile retrieved using a recipient terminal address in the communication initiation (i.e., see at least paragraphs 0031-0033, figure 5 and claim 10), the service profile specifying a service plan and terminal capability of the recipient terminal and terminal capability of the recipient terminal to retrieve the enhanced originator information from the originator terminal (i.e., see at least paragraphs 0031-0033, figure 5 and claim 10); processing the service profile to determine types of information elements that the recipient terminal receives to make an enhanced originator identification of the originator terminal (i.e., see at least paragraphs 0031-0033, figure 5 and claim 10); retrieving information elements associated with the originator terminal from a network database (i.e., see at least paragraphs 0034-0035 and figures 6 and 7), the retrieving based upon at least one of the service plan and terminal capability of the recipient terminal (i.e., see at least paragraphs 0031-0035 and figures 6 and 7); and transmitting a communication including said information elements to the recipient terminal prior

to establishing a communication session with the recipient terminal (i.e., see at least figures 5-8 and claims 1, 8, and 16) wherein the transmitting is conducted over at least one of: an IP network, a PSTN, peer to peer, a WLAN, a wireless network, a cable network a fiber optic network, a video network, and a satellite network (i.e., see at least figures 5-8 and claims 1, 8, and 16)

However, Mun does not specifically disclose selecting two or more information elements by retrieving two or more information elements from a network database wherein the information elements include advertising material.

In analogous art, Hwang teaches selecting two or more information elements by retrieving two or more information elements from a network database wherein the information elements include advertising material (e.g., see **paragraph 0029, figures and abstract**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mun to include selecting two or more information elements by retrieving two or more information elements from a network database wherein the information elements include advertising material for the purpose of proving caller id including an advertisement.

Consider **claims 2, 9 and 16 and as applied to claims 1, 8, and 15 above**, Mun as modified by Hwang teaches wherein the terminal capability relates to at least one of a: terminal device type including at least one of: a personal computer, a network computer, a wireless mobile telephone, a wireless mobile computer device, a facsimile, a network appliance, and a wire-line telephone, and terminal device technology features including at least one of: binary-

based caller-identification feature; and graphical features (i.e., see at least abstract and paragraph 0008).

Consider claims 4, 11, and 18 and as applied to claims 1, 8, and 15 above, Mun as modified by Hwang teaches wherein the communication comprises at least one of: Voice; Data; Video; Messaging; Instant Messaging; and Paging (i.e., see at least abstract and paragraph 0008).

Consider claims 5 and 12 and as applied to claims 1 and 8 above, Mun as modified by Hwang teaches wherein the communication including the tow or more said information elements are generated by said communications network (i.e., see at least abstract and paragraph 0008).

Consider claims 6, 13, and 19 and as applied to claims 1, 8, and 15 above, Mun as modified by Hwang teaches wherein the communication network includes at least one of: a circuit-switched network; a packet-switched network; a wireless network; an asynchronous transfer mode network; and a Multi-protocol Label Switching (MPLS) (i.e., see at least paragraph 0008).

Consider claims 7 and 14 and as applied to claims 1 and 8 above, Mun as modified by Hwang teaches wherein the service plans (i.e., subscriber data) are stored in a service profile database (i.e., see at least paragraphs 0034-0035 and figures 6 and 7), the plans stored in a dual format operable for accommodating both graphically-enabled caller identification devices and caller identification devices that are not graphically enabled (i.e., see at least paragraphs 0031-0035 and figures 6 and 7).

Consider claims 21, 22, and 23 and as applied to claims 1, 8, and 15 above, Mun as modified by Hwang teaches wherein the service plan includes controlling the presentation of the

communication of the recipient terminal by screening the two or more information elements in the communication based upon at least one of the content and format of the information elements (i.e., users register PCID registration mode beforehand and can use still image, characters, or moving pictures)(i.e., see at least paragraph 0024,0028-0029), the screening performed based upon criteria configured by a user of the recipient terminal (i.e., users register PCID registration mode beforehand and can use still image, characters, or moving pictures)(i.e., see at least paragraph 0024,0028-0029) .

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Shedrick whose telephone number is (571)-272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid Lester can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number:
10/713,939
Art Unit: 2617

Page 7

Charles Shedrick
AU 2617
November 26, 2007


LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER